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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,844	06/30/2000	Kia Silverbrook	NPB004US	9775

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SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER

KARMIS, STEFANOS

ART UNIT PAPER NUMBER

3624

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/607,844

Applicant(s)

SILVERBROOK ET AL.

Examiner

Stefano Karmis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

## A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The following office action is in reply to Applicants' amendment filed on 31 December 2003.

#### ***Status of Claims***

2. Claims 1-4, 9-10, 12-16, 21, 23-27, and 29-35 have been amended in the same amendment. Claims 5-8, 11, 17-20, 22, and 28 have been left as originally filed. Therefore claims 1-35 are under prosecution in this application.

#### ***Response to Arguments***

3. Applicant's arguments, with respect to the rejection(s) of claim(s) 1-35 under 35 U.S.C. 102 and 35 U.S.C. 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Roberts, U.S. Patent 5,772,510.
4. Applicant's arguments with respect to claims 1-35 have been considered but are moot in view of the new ground(s) of rejection.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-15, 17 and 32-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-16 and 26-27 of U.S. Patent No. 6,457,883. Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite means or steps that are substantially the same and that would have been obvious to one of ordinary skill in the art.

Claims 1 and 32 essentially repeat most of the features listed in U.S. Patent 6,457,883. Claims 1 and 32 of '883 do not recite the limitation of "account means being responsive to the account data for selectively accumulating a credit that is allocated to the user and which is redeemable by the user for obtaining selected goods and/or services," and the features of the dependent claims depending on these claims.

The omission of an element with a corresponding loss of function is an obvious expedient. See *In re Karlson*, 136 USPQ 184 and *Ex parte Rainu*, 168 USPQ 375. Instant

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claims 1 and 32, the deletion of certain elements and the statements in the alternatives would have an obvious expedient as above.

7. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) would overcome an actual or provisional rejection on a non-statutory double patenting ground provided the conflicting patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 7-9, 12-29 and 32-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Roberts U.S. Patent 5,772,510.

Regarding claims 1 and 32, Roberts discloses a method and system for providing printed information to a user including: a user interfaces with an electronic object database containing printed media, requests a certain document from the database and then allowing the document to be displayed or printed by the user (column 7, lines 5-23).

An identifier is applied to the printed media such that when the user selects the desired document a second printed media is sent to the user from the payment information database (column 7, lines 5-23 and Fig. 2A).

The system also comprises a memory means for storing account data and records of the objects the user purchases (column 4, lines 8-21 and Fig 8B).

Claims 2 and 33, both of the databases are accessed through a server connecting the databases (column 3, line 56 thru column 4, line 21 and Fig 1). A calculation is based on account data for determining the amount of payment that is made to the user (column 4, line 65 thru column 5, line 23).

Claims 3 and 4, the server means for constituted by respective hardware and software as well as common hardware and/or software (column 3, line 56 thru column 4, line 21 and Fig 1).

Claim 7, wherein the databases are comprised of different portions of a single database (column 3, line 56 thru column 4, line 21 and Fig 1).

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Claim 8 and 9, the first and second parties are of the same legal entities (column 7, lines 1-23) and whereupon the second information is derived from a fourth party and the calculation means is responsive to account data for determining a financial debit (column 5, line 46 thru column 6, line 25).

Claim 12, the printer module is provided to the user by a third party and the calculation unit is responsive to the account data for determining a financial debit to be applied by the third party against the first party or by the third party against the second party (column 5, line 46 thru column 6, line 25).

Claim 13, a financial debit is to be applied by the third party against the first party in proportion to the number of times second information was obtained by the printer module from the first database; and a financial debit to be applied by the third party against the second party in proportion to the number of times second information was obtained by the printer module from the second database (column 7, lines 45-65).

Claim 14 and 15, a plurality of printer modules and a corresponding plurality of users and the calculation unit it responsive to the central separate memory for determining the number of times in total that the first and second databases are accessed by the printer modules (column 4, line 22 thru column 5, line 24).

Claim 16 and 17, the account means maintains an account balance for the printer module and is credited as a function of the number of times the first or second information is accessed (column 7, lines 45-65 and Fig. 2A).

Claim 18-22, the account balance is debited at a predetermined interval and credited as a function of the number of times the first or second information is accessed in the preceding interval. When the credit balance exceeds a predetermined threshold, the user is eligible to claim one or more benefits from the supplier of goods or services (column 5, line 46 thru column 6, line 25).

Claim 23-25, calculation unit to determine payments amounts for first and second parties (column 5, line 46 thru column 6, line 25 and Fig. 2b).

Regarding claims 26 and 34, Roberts discloses a method and system for providing printed information to a user including: a user interfaces with an electronic object database containing printed media, requests a certain document from the database and then allowing the document to be displayed or printed by the user (column 7, lines 5-23).

An identifier is applied to the printed media such that when the user selects the desired document a second printed media is sent to the user from the payment information database (column 7, lines 5-23 and Fig. 2A).

The system also comprises a memory means for storing account data and records of the objects the user purchases (column 4, lines 8-21 and Fig 8B).



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A payment determination unit responsive to the account data for calculating an access fee to be levied against the user for the user of the printer module (column 5, line 61 thru column 6, line 25).

Claim 27 and 35, a predetermined periodic fee and a variable credit is derived from the account data (column 5, line 61 thru column 6, line 25).

Claim 28-29, account data is a number and the variable credit is derived from a multiple of that number and contains a positive value for the access fee (column 5, line 61 thru column 6, line 25 and Fig. 2b).

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 5-6, 10-11 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes et al. (hereinafter Holmes) U.S. Patent 6,119,108.

Claim 5, Roberts teaches wherein the databases are comprised of different portions of a single database (column 3, line 56 thru column 4, line 21 and Fig 1). Roberts fails to specify two separate databases. Official Notice is taken that multiple databases in a computer network are old and well known in the art. Therefore it would be obvious to anyone of ordinary skill in the art, that the teachings of Roberts could be modified to have the information first printed on the

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ticket and the required information when the ticket is bought come from separate databases because it is an acceptable and efficient manner to query for desired information.

Claim 6, Roberts teaches that the first and second parties are of the same legal entities (column 7, lines 1-23). Roberts fails to teach allowing for separate legal entities. Official Notice is taken that allowing for separate legal entities to access printable information is old and well known in the art. Therefore it would be obvious to one of ordinary skill in the art that the teachings of Roberts could be modified for the separate legal entities to access the system because it provides for a more diverse architecture and allows for any desired outside influence.

Claims 10 and 11, Roberts teaches that the first and second parties are of the same legal entities (column 7, lines 1-23). Roberts also teaches a memory means for storing account data and records of the objects the user purchases (column 4, lines 8-21 and Fig 8B). Winnings are proportional to the number shown on the ticket (column 4, lines 8-21 and Fig 8B). Roberts fails to teach allowing for separate legal entities. Official Notice is taken that allowing for separate legal entities to access printable information is old and well known in the art. Therefore it would be obvious to one of ordinary skill in the art that the teachings of Roberts could be modified for the separate legal entities to access the system because it provides for a more diverse architecture and allows for any desired outside influence.

Claims 30-31, Roberts teaches a predetermined periodic fee and a variable credit is derived from the account data (column 5, line 61 thru column 6, line 25). Roberts fails to teach

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that the access fee is calculated periodically and that after a user inserts the desired credit a selection must be made within a predetermined period of time. Official Notice is taken that periodically changing the fee of terminal and providing periodic time limits to enter a selection is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art to modify the teachings of Roberts to include the ability to periodically calculate fees and disabling the terminal if the fee is not paid because it provides safety and security for the user of the terminal so that another user accessing the terminal afterwards may not take advantage of a previous mishap by a previous customer.

***Requirement for information***

1. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The information required is for the purpose of determining potential double patenting for the entire pending commonly assigned patent applications cited by the Applicant:

Applicant is required to supply a copy of the pending claims of each of the cited applications. Applicant has indicated in paper number 7, pages 8-9 that each of the cited applications may contain related subject matter.

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This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

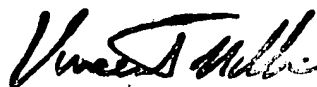
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully Submitted  
Stefano Karmis  
01 March 2004



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